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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,835	01/14/2002	Sien-Chun Chou	56868 (71987)	5690
21874	7590	10/03/2003	EXAMINER	
EDWARDS & ANGELL, LLP P.O. BOX 9169 BOSTON, MA 02209			OH, TAYLOR V	
		ART UNIT	PAPER NUMBER	
		1625		
DATE MAILED: 10/03/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/047,835	CHOU ET AL.
	Examiner Taylor Victor Oh	Art Unit 1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 01 April 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2 and 4-17 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,15 and 17 is/are rejected.

7) Claim(s) 2, 4-14, and 16 is/are objected to..

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____

**Final Rejection**

**The Status of Claims**

Claims 1-2, 4-17 are pending

Claims 1, 15, and 17 have been rejected.

Claims 2, 4-14, and 16 have been objected.

**Claim Rejections - 35 USC § 112**

1. Applicants' argument filed 4/1/2003 have been fully considered but are not persuasive.

The rejection of claims 2 and 8 has been withdrawn due to the modification made in the amendment. However, there are still 112 issues in claims 1, 15 ,and 17.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for nitrocompounds, such as NO and NO<sub>2</sub> , does not reasonably provide enablement for all the nitro compounds in the field of chemistry. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to all the nitro compounds unrelated to the current invention commensurate in scope with these claims. Therefore, an appropriate correction is required. Furthermore, there are "foreman factors or Wands factors" regarding unpredictability because nitrocompounds include heterocyclic compounds containing nitrocompounds, aromatic compounds containing nitrocompounds, alicyclic compounds containing nitrocompounds, and a diverse scope of acyclic compounds

containing nitrocompounds. In addition, it does not exclude bi-functional groups containing nitrocompounds. Moreover, as the molecular weight varies substantially, therefore, not all nitrocompounds are gaseous and also more than routine experimentation is involved. See In re Armbruster 185 USPQ 204 (CCPA 1985) and Angstadt et al. , 190 USPQ 152 (CCPA 1990).

Claims 1 ,15, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 , a phase “half-esterified intermediates” is written. However, this is vague and indefinite. The specification does not specify clearly what half-esterified intermediates are obtained from the process.

In claims 15 and 17, a phase “ packing type ” is written. However, the word “type” is vague and indefinite. This expression does not describe clearly what kind of the distillation apparatus is used. Therefore, an appropriate correction is required.

#### **In response to Argument**

Applicants argue that, according to the specification, all nitro compounds are enabled. However, the specification discloses NO and NO<sub>2</sub> as for nitrocompounds, they do not reasonably provide enablement for all the nitro compounds in the field of chemistry. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to all the nitro compounds unrelated to the current invention commensurate in scope with these claims. Furthermore, there

are "foreman factors or Wands factors" regarding unpredictability because nitrocompounds include heterocyclic compounds containing nitrocompounds, aromatic compounds containing nitrocompounds, alicyclic compounds containing nitrocompounds, and a diverse scope of acyclic compounds containing nitrocompounds. In addition, it does not exclude bi-functional groups containing nitrocompounds. Moreover, as the molecular weight varies substantially, therefore, not all nitrocompounds are gaseous and also more than routine experimentation is involved. See In re Armbruster 185 USPQ 204 (CCPA 1985) and Angstadt et al. , 190 USPQ 152 (CCPA 1990).

Claims 2, 4-14, and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Victor Oh whose telephone number is (703) 305-0809. The examiner can normally be reached on 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703) 308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

*Victor V. Oh  
9/30/03*

*Alan L. Rotman*  
ALAN L. ROTMAN  
SUPERVISORY PATENT EXAMINER  
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